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October 21, 2021

BY E-FILE

The Honorable Christopher J. Burke
United States District Court of Delaware
844 North King Street
Wilmington, DE 19801

REDACTED - PUBLIC VERSION

Re: *Sysmex Corp. & Sysmex America, Inc. v. Beckman Coulter, Inc.* No. 1:19-cv-01642-RGA-CJB

Dear Judge Burke:

Sysmex's motion to compel should be denied. (D.I. 372). The complete record makes clear that Sysmex is not entitled to the protected annotations made by BCI's technical expert, John Roche, nor is Sysmex entitled to re-depose Mr. Roche.

I. Factual Background

Sysmex had a full and fair opportunity to examine Mr. Roche on his opinions. The deposition began in the morning of Friday, August 6, 2021. BCI granted Sysmex's counsel 7 hours and 20 minutes on the record to complete the initial examination of Mr. Roche, who answered the questions put to him to the best of his ability. Afterwards, BCI's counsel conducted a re-direct examination (42-minutes) based on the topics covered by Sysmex's attorney. Taking nearly a 20-minute break following the completion of the re-direct examination, Sysmex's counsel proceeded to aggressively re-cross Mr. Roche at 7:04 p.m. CDT and refused to estimate how long he needed to question the witness. (Ex. A at 233:2–6, 248:3–19.) BCI then informed Sysmex of Mr. Roche's flight plans, as BCI previously had no reason to believe that the deposition would last until the evening. (*Id.*) Sysmex's attorney was permitted almost 30 minutes of additional questioning for re-cross.

Following the additional time for re-cross, Sysmex's attorney insisted on an immediate meet and confer on the record regarding the production of certain annotations prepared by Mr. Roche. (*Id.* at 252:19–257:9.) Sysmex's counsel rejected BCI's request to go off the record, even briefly, to discuss how the issue might be resolved. (*Id.* at 252:9–255:15.) These demands came at 7:30 p.m. on a Friday evening, after Mr. Roche had provided *nearly 8 hours of cross-examination on the record*. Given real-world time constraints, the length of Mr. Roche's testimony, and Sysmex's refusal to permit the court reporter and videographer to go off the record for even a moment, BCI was left with no choice but to terminate the deposition.

Contrary to Sysmex's argument, Mr. Roche testified at length that he carefully considered Dr. Paul Robinson's arguments before responding to them in his reply. (*Id.* at 206:8–208:8.) Since Dr. Robinson repeated and re-repeated many of the same opinions using the same language in his expert report, Mr. Roche grouped those opinions into "classes" while also focusing on the non-repetitive portions of that report. (*Id.* at 208:1–213:8.) Through this process, Mr. Roche was able to identify the flaws in Dr. Robinson's logic. (*Id.* at 207:5–13, 208:2–8.) Further, Mr. Roche testified that the annotations presently sought by Sysmex were central to the drafting of his reply report. Mr. Roche created them as part of his drafting process as he evaluated Dr. Robinson's report, and he relied on them to formulate and prepare his rebuttal opinions. (*Id.* at 207:14–24, 236:4–23.)

II. Mr. Roche's Annotations Are Work Product and Exempt from Production

Sysmex has no right to Mr. Roche's annotations because they are draft reports covered by Fed. R. Civ. P. 26(b)(4). As Mr. Roche explained, his annotations are "essentially the beginning of . . . [his] reply report." (Ex. A at 236:5–12.) Mr. Roche confirmed that he prepared these notes during his review of Dr. Robinson's opinions so that the information reflected in his notes would be later incorporated into his own report. (*Id.* at 236:16–23 ("I would create a comment next to Paragraph 15 or 425 [of Dr. Robinson's report] and put in the comments that became part of . . . the beginning of the rebuttal report.")) In fact, Mr. Roche's testimony establishes that his annotations are preliminary drafts of his reply report. See *In re Nat'l Hockey League Players' Concussion Inj. Litig.*, No. MDL142551SRNJSM, 2017 WL 684444, at *4 (D. Minn. Feb. 21, 2017) (protecting an annotated bibliography as a draft because an expert created the document and included the information in his report); *Deangelis v. Corzine*, No. 1:11-CV-07866-VM-JCF, 2016 WL 93862, at *5 (S.D.N.Y. Jan. 7, 2016) ("The documents were prepared not simply to aid [the expert] in drafting his report, but rather to form part of the report itself and were in fact included in preliminary versions of that report. They are, in short, drafts of his report."). Because drafts warrant work product protection "regardless of the form in which the draft[s] [are] recorded," Mr. Roche's annotations are not discoverable. Fed. R. Civ. P. 26(b)(4).

Sysmex's arguments otherwise are untenable for three reasons. *First*, *Wenk v. O'Reilly*, No. 2:12-CV-474, 2014 WL 1121920, at *7 (S.D. Ohio Mar. 20, 2014), cited by Sysmex, undermines its assertions, as Fed. R. Civ. P. 26(b)(4)(B) explicitly states that draft reports need not be "so labeled or be in any particular format."¹ *Second*, BCI has not waived work product immunity via the shield and sword doctrine. The classic shield and sword scenario occurs when a party affirmatively discloses a matter protected by privilege to prove a claim or defense while simultaneously invoking privilege to prevent discovery into that matter. Here, Mr. Roche did not selectively reveal the substance of his annotations to support a legal issue. His explanation of the existence and purpose of his drafts does not result in waiver. See *Dutch Branch of Streamserve Dev, AB v. Exstream Software, LLC*, No. 08-343-SLR, 2009 WL 2705932, at *1 (D. Del. Aug. 26, 2009). *Third*, Sysmex has neither shown that the annotations are relevant to any claim or defense nor articulated a substantial need or undue hardship. See *Medicines Co. v. Mylan Inc.*, No. 11-cv-1285, 2013 WL 2926944, at *5 (N.D. Ill. June 13, 2013). In fact, Sysmex has not identified any specific testimony that it wants to verify. To the extent that it seeks to confirm that Mr. Roche reviewed Dr. Robinson's report, Mr. Roche's testimony and reply already provide ample support.

III. Sysmex Is Not Entitled to Reopen Mr. Roche's Deposition

Sysmex's request to reopen Mr. Roche's deposition should also be denied. Mr. Roche had testified for more than 8 hours in his deposition in this case and for nearly *12 hours* in two depositions for a co-pending *inter partes* review (IPR) between the parties, which relates to the same subject matter as the present litigation and on which Sysmex has relied in this litigation. (Ex. B.) A re-deposition now is unwarranted, as Sysmex identifies no topic for which it seeks to re-depose Mr. Roche. Mr. Roche has provided meaningful and detailed responses in his deposition, in marked contrast with the long-winded and evasive testimony provided by Sysmex's expert, Dr. Robinson. (Ex. C.) In any event, Sysmex will likely have an opportunity to depose Mr. Roche again after service of a supplemental report. (D.I. 373.) No good cause exists to allow Sysmex yet another bite of the apple. See *Haskins v. First American Title Ins. Co.*, No. 10-5044 (RMB/JS), 2013 WL 5410531, at *6 (D.N.J. Sept. 26, 2013).

¹ *Windowizards, Inc. v. Charter Oak Fire Ins. Co.*, No. 13-7444, 2015 WL 1402352 (E.D. Pa. Mar. 26, 2015), also cited by Sysmex, does not address the protection of notes later incorporated into an expert report.

Young Conaway Stargatt & Taylor, LLP

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Respectfully,

/s/ Melanie K. Sharp

Melanie K. Sharp (No. 2501)

cc: Counsel of Record, Kelly F. Farnan, Esq. (by e-mail)

28737206.1

EXHIBIT A

John Roche
August 06, 2021

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

SYSMEX CORPORATION and)	
SYSMEX AMERICA, INC.,)	
)	
Plaintiffs,)	
)	
vs.)	No. 19-1642-RGA-CJB
)	
BECKMAN COULTER, INC.,)	
)	
Defendant.)	

The VIDEOTAPED REMOTE DEPOSITION of JOHN
ROCHE, pursuant to notice and pursuant to the Rules
of Civil Procedure for the United States District
Courts pertaining to the taking of depositions, taken
before Barbara Perkovich, CSR No. 084-004070,
Certified Shorthand Reporter, on the 6th day of
August 2021 at 9:00 a.m..

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1 REMOTE APPEARANCES:

2 CROWELL & MORING, LLP

BY: MR. JAMES SOBIERAJ

3 455 North Cityfront Plaza Drive

Suite 3600

4 Chicago, Illinois 60611

(312) 321-4200

5 jsobieraj@crowell.com

Appearing on behalf of the Plaintiffs;

6 LEYDIG, VOIT & MAYER, LTD.

7 BY: MR. AARON R. FEIGELSON

Two Prudential Plaza

8 180 North Stetson Avenue

Suite 4900

9 Chicago, Illinois 60601

(312) 616-5600

10 afeigelson@leydig.com

Appearing on behalf of the Defendant.

11
12 ALSO PRESENT: John Schmitzer, Videographer
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1 MR. FEIGELSON: We've given an extra 20
2 minutes here, but obviously you can do as you
3 wish. But I have some questions for
4 Mr. Roche that I would like to get in before
5 it gets later in the day.

6 EXAMINATION

7 BY MR. FEIGELSON:

8 Q. Mr. Roche, do you recall this morning
9 counsel asking you, Mr. Sobieraj asking you about
10 Dr. Robinson's invalidity expert report?

11 A. Yes.

12 Q. That is the 600-plus page report?

13 A. Yes.

14 Q. And just to clarify your testimony,
15 Mr. Roche, you indicated that his report was over
16 600 pages and that you just skimmed portions of
17 the report. Can you explain why you did that?

18 A. I think in the previous questioning we
19 went through, let's say the core front of the
20 document, that was the basis of my either reply or
21 rebuttal report, I forget which one. And then the
22 balance of the rest of the document had a lot of
23 repetitiveness from the claims.

24 So I went through them quickly.

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1 Skimming might not be the best term, but to scroll
2 down and look for repetitiveness and then go
3 through it. It was still hours to go through the
4 skimming.

5 Q. Other than the repetitiveness, those
6 portions, did you consider the portions that
7 weren't repetitive in Dr. Robinson's report?

8 A. Absolutely. I think I started my
9 rebuttal or reply or whatever term it was, on the
10 items I disagreed with his characterization,
11 especially concerning, red cells -- being able to
12 count red cells -- or white cells in the red cell
13 electrical detector.

14 Q. You mentioned that you prepared a reply
15 report to Dr. Robinson's reports. Did you
16 carefully consider all of the paragraphs of
17 Dr. Robinson's report that you responded to in
18 your reply?

19 MR. SOBIERAJ: Objection, leading.

20 THE WITNESS: Yes, I believe I
21 annotated, on the documents that I can write
22 on, I annotated the details of the 600-page
23 document fairly well in the document I was
24 reviewing.

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1 BY MR. FEIGELSON:

2 Q. Did you choose which sections of

3 Dr. Robinson's report required a reply?

4 A. Yes. I went through the items and
5 replied specifically, and hopefully in depth, to
6 the ones that are nonrepetitive in nature. And
7 the ones that were repetitive in nature, we had
8 grouped into the mode classes.

9 Q. Let's actually look at your reply. So
10 this is PDX 187. Can you look at Paragraph 40 on
11 Page 22.

12 A. Yes.

13 Q. And in the second sentence of Paragraph
14 40 it says, "For example, Dr. Robinson repeatedly
15 notes over 20 times in Paragraphs 238, 249, 311,
16 348, 472, 489, 508, 519, 570, 611, 639, 646, 684,
17 724, 766, 844, 856, 865, 964, 1016, 1026, 1034,
18 1047, 1359, and 1368, that the presequence process
19 of the patents include steps of running a cell
20 free blank sample to check for the background
21 counts against the threshold as well as automated
22 prewashing."

23 Do you see that sentence, Mr. Roche?

24 A. Yes, I do.

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1 Q. And did you carefully consider -- I'm
2 going to strike that.

3 You list -- so you listed out all of
4 these paragraphs where Dr. Robinson repeated this
5 statement, correct?

6 A. Correct.

7 Q. Can we look at Paragraph 52 of your
8 reply, please. And in Paragraph 52, at the end of
9 the second line, again you see a sentence that
10 says that, In Paragraph 191 of Dr. Robinson's
11 report he repeats a paragraph a number of times;
12 is that correct? In at least 10 places?

13 A. That's correct.

14 Q. Can we turn to Paragraph 56, which is
15 on Page 29. And here you write that Dr. Robinson
16 again repeats throughout his report a
17 misinterpretation of an unreliable reliance on
18 general attorney arguments made in a BCI brief,
19 correct?

20 MR. SOBIERAJ: Mr. Roche, you have to
21 slow down, you're not giving me a chance to
22 make objections. I object to all these
23 questions as leading. And I'm going to
24 have -- I object to the last question as

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1 leading as well.

2 MR. FEIGELSON: Counsel, you've had
3 plenty of time to make your objections and
4 you still can.

5 MR. SOBIERAJ: That's not true.

6 BY MR. FEIGELSON:

7 Q. Mr. Roche, in Paragraph 56 of your
8 reply you state that Dr. Robinson repeats a
9 misinterpreted attorney argument throughout his
10 brief, correct?

11 MR. SOBIERAJ: Objection, leading.

12 THE WITNESS: I'm sorry, could you
13 point me to...

14 BY MR. FEIGELSON:

15 Q. The first line of Paragraph 56 you say
16 that, "Dr. Robinson repeats throughout his report
17 a misinterpretation of and an unreasonable
18 reliance on general attorney argument made in a
19 BCI brief"?

20 MR. SOBIERAJ: Objection.

21 THE WITNESS: Yes, that's what it says.

22 BY MR. FEIGELSON:

23 Q. And you then list at least 17 places in
24 Dr. Robinson's report where he included that

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1 statement; is that correct?

2 MR. SOBIERAJ: Objection, leading.

3 THE WITNESS: That's what the report
4 says.

5 BY MR. FEIGELSON:

6 Q. Can you look at Paragraph 61 of your
7 reply. See Paragraph 61?

8 A. Yes, I do.

9 Q. And in Paragraph 61 you list out over
10 32 paragraphs where Dr. Robinson has included the
11 same argument, correct?

12 MR. SOBIERAJ: Objection, leading.

13 THE WITNESS: Yes.

14 BY MR. FEIGELSON:

15 Q. Sorry, that was Paragraph 61 that I was
16 just referring to.

17 A. Yes, the same argument is made in all
18 the paragraphs listed.

19 Q. And in Paragraph 62, you make a
20 reference to at least six different paragraphs of
21 Dr. Robinson's report that includes the same
22 statement, correct?

23 MR. SOBIERAJ: Objection, leading.

24 THE WITNESS: Yes, that's correct.

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1 BY MR. FEIGELSON:

2 Q. And in Paragraph 63, you list at least
3 18 different paragraphs that include the same
4 argument -- the same words of Dr. Robinson,
5 correct?

6 MR. SOBIERAJ: Objection, leading.

7 THE WITNESS: Yes, that's what the
8 report says.

9 BY MR. FEIGELSON:

10 Q. Let's look at Paragraph 78. Paragraph
11 78, on the second and third line, you again list
12 at least 17 unique paragraphs where Dr. Robinson
13 provides the same opinion, correct?

14 MR. SOBIERAJ: Objection, leading.

15 THE WITNESS: Yes, that's correct.

16 BY MR. FEIGELSON:

17 Q. Let's look at Paragraph 83. In
18 Paragraph 83, you cite to 9 different paragraphs
19 of Dr. Robinson's report, correct?

20 MR. SOBIERAJ: Objection, leading.

21 THE WITNESS: Yes.

22 BY MR. FEIGELSON:

23 Q. And you cite them that in each of those
24 paragraphs Dr. Robinson makes the same statement,

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1 correct?

2 A. He does.

3 MR. SOBIERAJ: Objection.

4 BY MR. FEIGELSON:

5 Q. And you determined from your review of
6 Dr. Robinson's report that all of these sets of
7 paragraphs that we listed were the same, correct?

8 A. Correct.

9 MR. SOBIERAJ: Objection, leading.

10 BY MR. FEIGELSON:

11 Q. Mr. Roche, let's look at Exhibit C of
12 your opening report, which is PDX 185. And I
13 would like you to turn to Page 3 of Exhibit C,
14 please. Do you have that in front of you?

15 A. I am there. I'm not sure if they're
16 going to catch up on the screen or not.

17 Q. I'm sorry that's the wrong exhibit.
18 I'm thinking of Exhibit E to your report. Can you
19 look at Exhibit E to your report, please? Do you
20 have that in front of you?

21 A. Exhibit E comparison with the XE-2100
22 analyzers.

23 Q. And then on Page 3, can you look at
24 Page 3?

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1 MR. SOBIERAJ: At least 10.

2 THE VIDEOGRAPHER: Going off the
3 record. The time is 23:46 UTC.

4 (Break taken.)

5 THE VIDEOGRAPHER: We are back on the
6 record, the time is 00:04 UTC. Please
7 proceed.

8 FURTHER EXAMINATION

9 BY MR. SOBIERAJ:

10 Q. Mr. Roche, during the questioning by
11 Mr. Feigelson, you indicated that you had made
12 some annotations on your expert reports which
13 would provide some indication of which paragraphs
14 you had reviewed in Dr. Robinson's report,
15 correct?

16 MR. FEIGELSON: Objection.

17 Mischaracterizes the witness's testimony.

18 THE WITNESS: My thought process was to
19 get a Word -- I'm sorry, to take the pdf and
20 to invert it to Word so I could make notes or
21 comments within the document and to search
22 the document more efficiently.

23 BY MR. SOBIERAJ:

24 Q. Which document are you referring to?

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1 report, as a pdf and then you converted it to a
2 Word document?

3 A. Yes, that's correct.

4 Q. And in that Word document, you made
5 annotations in various forms; is that correct?

6 A. Yes. So to -- for example, I would add
7 a comment, you know, it was essentially the
8 beginning of my -- either the reply report or the
9 rebuttal report, I'm not sure which, to bring in
10 figures or, I think there was some spreadsheets
11 that I created to do some of the math based on
12 numbers that Dr. Robinson had proposed.

13 Q. And would those spreadsheets provide an
14 indication of which paragraphs of Dr. Robinson's
15 report you reviewed carefully?

16 A. The -- they were basically pasted in as
17 comment fields. So, you know, you use Word to
18 create a comment. I would create a comment next
19 to Paragraph 15 or 425 and put in the comments
20 that became part of my rebuttal items on, like I
21 said, as the beginning of the rebuttal report.
22 And then clean that up to create the prose of that
23 report.

24 Q. When you say a comment, are you talking

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1 Mr. Narisada, correct?

2 A. Yes, it does.

3 MR. FEIGELSON: Counsel, before you ask
4 another question, we've been going for 23
5 minutes now. I need to know how long you're
6 planning to go. We can give you 5 more
7 minutes and then Mr. Roche needs to take a
8 flight. We have been extremely generous
9 already.

10 MR. SOBIERAJ: I appreciate the 5
11 minutes, but I'll probably need more time
12 than that the way this is going.

13 MR. FEIGELSON: We have been on the
14 record for 8 hours and 25 minutes and it's
15 7:28 p.m. on a Friday in Chicago.

16 Mr. Roche needs to catch a flight
17 to get to San Francisco, so I will give you 5
18 more minutes, then we need to close the
19 deposition.

20 MR. SOBIERAJ: I'm not going to agree
21 that the deposition is closed, but I'll make
22 as much progress as I can in the next 5
23 minutes.

24

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1 are, but with removing the hematology items
2 from the terms Madisetti and Robinson
3 provided, I would assume he would be
4 qualified as a POSA.

5 BY MR. SOBIERAJ:

6 Q. Under Dr. Robinson's standard, you're
7 saying he's qualified?

8 MR. FEIGELSON: We're done. That's the
9 end of the questions. We need to go.

10 MR. SOBIERAJ: I'm not agreeing to end
11 the deposition.

12 MR. FEIGELSON: We don't have a choice.

13 MR. SOBIERAJ: Yes, we do.

14 MR. FEIGELSON: We don't.

15 MR. SOBIERAJ: You opened a lot of
16 doors, Counsel. I still have quite a few
17 more questions to ask. I'm keeping the
18 deposition open.

19 And if you're going to instruct
20 the witness not to answer any more questions,
21 I would like you to stay on the record so we
22 can have a meet and confer about -- because
23 I'm officially requesting on the record here
24 that we receive an unaltered copy of the Word

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1 document that Mr. Roche created of
2 Dr. Robinson's 600-and-some page validity
3 report which includes the annotations made by
4 Mr. Roche. Will you agree to produce that?

5 MR. FEIGELSON: We will not, it's work
6 product as you know, it's protected under
7 Rule 26(a), but we need to stop today's
8 deposition.

9 MR. SOBIERAJ: Can we have a meet and
10 confer on that issue?

11 MR. FEIGELSON: We can go off the
12 record.

13 MR. SOBIERAJ: Can we have a meet and
14 confer?

15 MR. FEIGELSON: We can go off the
16 record and discuss it.

17 MR. SOBIERAJ: We've got a record,
18 let's have a meet and confer on the record.

19 MR. FEIGELSON: It is 7:35 on a Friday
20 night. We have been on the record since 9:00
21 a.m. this morning. Mr. Roche has a flight to
22 catch, I need to leave as well. We can talk
23 about this on Monday or over the weekend. We
24 can discuss it off the record.

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1 MR. SOBIERAJ: If we can discuss it off
2 the record now, why can't we discuss it on
3 the record now?

4 MR. FEIGELSON: We can go off the
5 record. Thank you.

6 MR. SOBIERAJ: No, I'm not agreeing to
7 go off the record, I want to have this
8 discussion on the record.

9 MR. FEIGELSON: We are going to leave,
10 as I've told you. It's 7:36. I'm happy to
11 have a discussion with you, Jim. And we can
12 have that discussion off the record.

13 MR. SOBIERAJ: I'm not agreeing to go
14 off the record.

15 MR. FEIGELSON: Well, people need to
16 eat and I think it's not being courteous to
17 John and to Barb and to the witness who needs
18 to catch a flight. So we have to leave.

19 MR. SOBIERAJ: Can we have the meet and
20 confer?

21 MR. FEIGELSON: We can schedule a meet
22 and confer.

23 MR. SOBIERAJ: Can we do it right now?

24 MR. FEIGELSON: We can do this off the

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1 record. In Delaware it's not -- it's not
2 advisable to have these discussions on the
3 record. You can call your local counsel.

4 MR. SOBIERAJ: That's not true. You
5 had a court reporter for a meet and confer.
6 You insisted on it.

7 MR. FEIGELSON: In front of the witness
8 during a deposition, it is not appropriate to
9 do this. We can have our discussion off the
10 record without the witness being present.

11 MR. SOBIERAJ: He can step outside the
12 room while we have our discussion on the
13 record.

14 MR. FEIGELSON: Jim, we can discuss
15 this.

16 MR. SOBIERAJ: We are, I'm happy to
17 discuss this. You had a court reporter for a
18 meet and confer.

19 MR. FEIGELSON: We are going off the
20 record now. I'm sorry, we have to go off the
21 record. Mr. Roche, thank you for your time
22 today. I know it's been a long day. You can
23 leave.

24 MR. SOBIERAJ: Just to make it clear, I

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1 haven't agreed to end the deposition.

2 THE VIDEOGRAPHER: Yeah, I need both
3 parties to agree to go off the record. Do
4 you want to stay on?

5 MR. SOBIERAJ: For a little bit. I
6 notice that Mr. Roche has left and
7 Mr. Feigelson has left, but they -- well,
8 they are not on the screen, but they haven't
9 signed off, they haven't left Zoom.

10 So I want to give them a chance
11 to reconsider and come back. If they leave
12 Zoom, then there is not much I can do.

13 Aaron, are you there? I see your
14 computer is still on. It's been over 5
15 minutes, Mr. Feigelson has walked out of the
16 room. He refused to have a meet and confer
17 on the record. The witness apparently has
18 left the room. It looks like he's still --
19 he's still connected to Zoom, but no one is
20 there. No one is responding.

21 So they're not even here to agree
22 to end the deposition now. They're not even
23 here to go off the record now. So I don't
24 want to keep the court reporter and

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1 videographer any longer. I'm sorry, you
2 know, you've had to stick around as long as
3 you have. I guess I'm not sure, though, can
4 we end the deposition?

5 So since Mr. Feigelson is not
6 here. We are going to go off the record.

7 THE VIDEOGRAPHER: We are going off the
8 record. The time is 00:43 minutes UTC. We
9 are now off the record.

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11 (Ending Time: 7:43 p.m.)
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EXHIBIT B

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

SYSMEX CORPORATION and SYSMEX AMERICA, INC.

Plaintiffs,

 \mathbf{V}_i

BECKMAN COULTER, INC.,

Defendant.

C.A. No.: 19-1642-RGA-CJB

JURY TRIAL DEMANDED

**HIGHLY CONFIDENTIAL –
SOURCE CODE**

**REPLY EXPERT REPORT OF VIJAY MADISETTI, PH.D. REGARDING
INFRINGEMENT OF U.S. PATENT NOS. 10,401,350 AND 10,401,351**

is incorrect. [REDACTED]

[REDACTED] See, e.g., ¶¶ 62-63 of my Opening Report. Additionally, I identified several operations performed by the Accused Products because that is required by the claims. The claims require “a controller programmed to selectively operate the sample analyzer in a blood measuring mode or a body fluid measuring mode,” wherein the modes include several operations. Therefore, in addition to identifying the controller in the Accused Products, I also identified the claimed operations performed by the Accused Products.

12. Martens appears to ignore the plain and ordinary meaning of a controller. Martens disagrees with the following definition: “[t]he plain and ordinary meaning of a controller is, from a functionality perspective, an element that controls another element.” Martens Report ¶ 34. Therefore, Martens disagrees with Roche. In an IPR proceeding involving certain claims from the ’351 patent, Roche provided that definition during his deposition. IPR2020-01503, Roche Tr. at 54:1-15. Also, Martens misconstrues the definitions of a controller in the technical literature. See Martens Report ¶ 35-37. For example, the IBM Dictionary of Computing defines a “controller” as a “*device that coordinates and controls the operation of one or more input/output devices, such as workstations, and synchronizes the operation of the system as a whole.*” Madisetti Ex. 19 at 145 (emphasis added). Also, Newton’s Telecom Dictionary defines a “controller” as “*a device which controls the operation of another piece of equipment.*” Madisetti Ex. 21 at 152 (emphasis added). The IEEE Standard Dictionary of Electrical and Electronics Terms defines “controller” as a “*device or group of devices that serves to govern, in some predetermined manner, the electric power delivered to the apparatus to which it is connected.*” Madisetti Ex. 20 at 217 (emphasis added). [REDACTED]

[REDACTED] Martens

XII. CLOSING REMARKS

57. If requested, I will testify regarding the opinions reached and the analysis set forth in this Report.

58. I expressly reserve the right to supplement this Report as requested in response to new information, including but not limited to subsequent rulings by the Court, newly-published court opinions, or based upon my review of the opinion(s) of Defendant's expert(s), additional specific scientific literature or information from Defendant or other relevant developments.

59. At trial, I may give a tutorial on any matters discussed in this report. I may also prepare and use demonstratives, charts, and other visual aids for any testimony in this case.

A handwritten signature in blue ink, appearing to read "Vijay K. Madiseti", is written above a horizontal line.

Vijay K. Madiseti, Ph.D.

Johns Creek, GA
July 16, 2021

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

**SYSMEX CORPORATION AND
SYSMEX AMERICA, INC.**

PLAINTIFFS,

V.

BECKMAN COULTER, INC.,

DEFENDANT.

C.A. NO.: 19-1642-RGA-CJB

JURY TRIAL DEMANDED

**HIGHLY CONFIDENTIAL –
SOURCE CODE**

**EXPERT REPORT OF J. PAUL ROBINSON CONCERNING THE
VALIDITY OF U.S. PATENT NOS. 10,401,350 AND 10,401,351**

resistance which this cell opposed in the field causes an increase of the voltage **required for the constancy of the current in accordance with Ohm's law.** The voltage pulse generated by the passage of this cell is proportional to the resistance opposed, so to its volume without consideration of form. *Id.*, 1:22-30

* * *

Counting and detection of the volume are provided by resistivity measurements. For this, a current is applied to the terminals of two electrodes situated on each side of orifice 12, namely an anode formed by end piece 8 of the discharge duct and a cathode formed of the internal injection nozzle 16. Counting of the leucocytes is then carried out during passage of the solution 20 through the calibrated orifice 12, each cell passing through the orifice causes an increase of the resistivity of the medium situated between the electrodes 8, 16, thus creating a voltage pulse proportional to the volume of the leucocyte. *Id.*, 5:14-26

Id., ¶¶ 124-125.

Thus, Lefevre expressly discloses that it was well known that electrical detectors were used to measure changes in the resistance between electrodes caused by passing cells (including white blood cells), and to generate voltage pulses that are directly proportional to the volume (i.e. size) of the cell. Roche agrees. IPR2020-1503 Ex. 2068, 192:23-193:13. Lefevre also teaches that this method of electrical resistivity analysis allows white blood cells to be differentiated, according to their size. IPR2020-01503 Ex. 1047, 1:49-51; *see also* Grace 30(b)(6) dep., 193:14-194:7. Lefevre further discloses that the electrical detector alone generates a histogram that shows the presence of distinct populations of white blood cells. IPR2020-01503 Ex. 1047, Fig. 3, 6:36-43; *see also* Grace 30(b)(6) dep., 202:7-10, 204:5-13.

C. The Evolution of Body Fluid Analysis

70. The analysis of body fluids is “medically important in the diagnosis of infectious and other inflammatory processes, hemorrhage, and malignancies that may involve body cavities and the central nervous system (CNS).” SAI-Del00122938. Tests on body fluid are often needed quickly to manage medical emergencies or because “specimen integrity is good for only a few

denied BCI's IPR petitions in each of IPR2020-01500, IPR2020-01501 and IPR2020-01502. The denials of institution of these IPR submissions also support my opinion and contradict Roche to the extent he is arguing that these figures somehow establish that the claims of the '350 and '351 patent are invalid.


IX. CLOSING REMARKS

1392. If requested, I will testify regarding the opinions reached and the analysis set forth in this Report.

1393. I expressly reserve the right to supplement this Report as requested in response to new information, including but not limited to subsequent rulings by the Court, newly-published court opinions, or based upon **my review of the opinion(s) of Defendant's expert(s), additional specific scientific literature or information from Defendant or other relevant developments.**

1394. At trial, I may give a tutorial on any matters discussed in this report. I may also prepare and use demonstratives, charts, and other visual aids for any testimony in this case.

Respectfully submitted,



J. Paul Robinson

Dated: June 25, 2021

John Roche
April 28, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

BECKMAN COULTER, INC.,)	
)	
)	
Petitioner,)	Case
)	IPR2020-01503
v.)	
)	U.S. Patent No.
SYSMEX CORPORATION AND)	10,401,351
SYSMEX AMERICA, INC.,)	

Patent Owner.

The discovery videotaped video
teleconference deposition of JOHN ROCHE, called
by the Patent Owner, for examination, pursuant
to notice, taken remotely before LAURA MUKAHIRN,
CSR, RPR, CRR, within and for the County of Cook
and State of Illinois, on April 28, 2021,
scheduled to commence at 10:00 o'clock a.m. CST.

EXHIBIT C

July 28, 2021

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

SYSMEX CORPORATION and)	
SYSMEX AMERICA, INC.,)	
)	
Plaintiffs,)	
)	No.
vs.)	19-1642-RGA-CJB
)	
BECKMAN COULTER, INC.,)	
)	
Defendant.)	

HIGHLY CONFIDENTIAL - SOURCE CODE

The discovery videotaped video
teleconference deposition of J. PAUL ROBINSON,
PH.D., called by the Defendant, for examination,
pursuant to notice, taken remotely before LAURA
MUKAHIRN, CSR, RPR, CRR, within and for the
County of Cook and State of Illinois, on July
28, 2021, scheduled to commence at 9:00 o'clock
a.m. CST.

July 28, 2021

A P P E A R A N C E S:

CROWELL & MORING LLP

BY: MR. JAMES SOBIERAJ

MR. JOSHUA JAMES

jsobieraj@crowell.com

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(312) 321-4200

Appeared on behalf of the Plaintiffs;

LEYDIG, VOIT & MAYER, LTD.

BY: MR. AARON FEIGELSON

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Chicago, Illinois 60601

(312) 616-5600

Appeared on behalf of the Defendant.

July 28, 2021

1 Figure 2. Therefore, in my opinion, a POSA
2 would understand that the specification does
3 disclose a controller that operates a multi-mode
4 detector to sense cells.

5 BY MR. FEIGELSON:

6 Q. And that last sentence, Dr. Robinson,
7 what exactly would the POSA understand was
8 disclosed in the specification as a controller?

9 A. Well, if we go to the patent and look
10 at Column 8, just above where you quoted, in
11 Line 30: Microcomputer 6 is provided with a
12 controller 63 configured with -- excuse me --
13 configured by a memory for the control processor
14 and the operation of the control processor and a
15 data analyzing unit 64 configured by memory for
16 the analysis processor and the operation of the
17 analysis processor. And it goes on then, with
18 my quote: The controller 63 controls the device
19 8 configured by a sampler, not shown in the
20 drawing, for automatically supplying blood
21 collection tubes and a fluid system and the like
22 for preparing and measuring samples as well as
23 performing other controls.

24 So I believe the specification the POSA
25 would be drawn to the specification to make that

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1 conclusion.

2 Q. So what is it specifically that the
3 POSA would understand to be the controller?

4 MR. SOBIERAJ: Objection. Asked and
5 answered.

6 THE WITNESS: As I stated, in Column 8 in
7 Line 30, the microcomputer 6 is provided with
8 the controller 63 -- and you'll note that is
9 shown in Figure 2 -- configured by a memory for
10 the control processor and the operation of the
11 control processor and the data analyzing unit 64
12 configured by a memory for the analysis
13 processor and the operation of the analysis
14 processor. The controller 63 controls the
15 device 8 configured by a sampler not shown in
16 the drawing for automatically supplying blood
17 collection tubes and a fluid system and the like
18 for preparing samples as well as performing
19 other controls. I think it's very clear.

20 BY MR. FEIGELSON:

21 Q. What do you think is clear?

22 A. Can you expand on that? That's a very
23 broad question what I think is clear.

24 Q. You made the statement, sir. You said
25 you think it's very clear. What do you think is

July 28, 2021

1 very clear?

2 A. I think you asked me why a POSA would
3 understand that the specification discloses a
4 controller, but I'm not exactly sure. That is
5 what I understood the question to be.

6 Q. So I'm not asking why -- sorry. I'm
7 not asking why a POSA would think that. I'm
8 asking what the POSA would understand to be the
9 controller in your opinion?

10 MR. SOBIERAJ: Objection. Asked and
11 answered.

12 THE WITNESS: Well, the specification
13 identifies this when it identifies 63 which
14 would be a nonlimiting example specified by the
15 patent. And so a POSA would evaluate those
16 statements and come to a conclusion based on
17 looking at Figure 2 as it was stated and the
18 statements in the specification.

19 BY MR. FEIGELSON:

20 Q. I just want to make sure I understand
21 your opinion, Dr. Robinson. When you say that a
22 POSA would understand that the specification
23 does disclose a controller that operates a
24 multi-mode detector to send cells, are you
25 referring to controller 63?

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1 MR. SOBIERAJ: Objection to the form of the
2 question.

3 THE WITNESS: What I've stated in my report
4 is that the specification discloses the
5 controller 63 controls the device 8 configured
6 by a sampler -- not shown in the drawing -- for
7 automatically supplying blood collection tubes
8 and a fluid system and the like for preparing
9 and measuring cells as well as performing other
10 controls. And I go on to say that the
11 controller, control unit, 63 is a component of
12 microcomputer 6 as shown in Figure 2.

13 BY MR. FEIGELSON:

14 Q. So are you referring to the controller
15 63 as the disclosed controller that a POSA would
16 understand is operating a multi-mode detector to
17 sense cells?

18 MR. SOBIERAJ: Objection to the form of the
19 question. Asked and answered.

20 THE WITNESS: What I'm saying is that the
21 specification in -- from 830 down to 844
22 explains to a POSA what a controller is.

23 BY MR. FEIGELSON:

24 Q. And can you explain that to the jury,
25 please, what the POSA would understand the

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1 controller to be?

2 MR. SOBIERAJ: Objection. Asked and
3 answered.

4 THE WITNESS: The specification discloses the
5 controller 63 controls the device 8 configured
6 by a sampler -- not shown in the drawing -- for
7 automatically supplying blood collection tubes
8 and the fluid system or the like for preparing
9 and measuring samples as well as performing
10 other controls. The controller, control unit,
11 63 is a component of microcomputer 6 as shown in
12 Figure 2.

13 BY MR. FEIGELSON:

14 Q. My question, sir, is for you to explain
15 to the jury exactly what the POSA would
16 understand from that to be the controller.

17 MR. SOBIERAJ: Objection. Asked and
18 answered.

19 THE WITNESS: It's very clear. The
20 specification discloses the controller 63
21 controls the device 8 configured by a sampler --
22 not shown in the drawing -- for automatically
23 supplying blood collection tubes and a fluid
24 system and the like for preparing and measuring
25 samples as well as performing other controls.

1 The controller, control unit, 63 is a component
2 of microcomputer 6 as shown in Figure 2.

3 BY MR. FEIGELSON:

4 Q. Now, you've been reading that paragraph
5 for each time I've asked -- or tried to ask the
6 question. But you're not answering my question
7 directly, sir. So I'm going to ask it again.
8 You give the opinion that a POSA would
9 understand that the specification discloses a
10 controller that operates a multi-mode detector
11 to sense cells. Correct?

12 MR. SOBIERAJ: I want to -- first I want to
13 object to your statement that the witness is not
14 answering your question directly as being
15 incorrect. And I also want to object to the
16 repeated question as having been asked and
17 answered.

18 BY MR. FEIGELSON:

19 Q. You can answer.

20 A. Could you repeat the question?

21 Q. You give the opinion that a POSA would
22 understand that the specification discloses a
23 controller that operates a multi-mode detector
24 to sense cells, correct?

25 A. Yes.

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1 Q. What is that controller, sir?

2 MR. SOBIERAJ: Objection. Asked and
3 answered.

4 THE WITNESS: Specification discloses the
5 controller 63 controls the device 8 configured
6 by a sampler -- not shown in the drawing -- for
7 automatically supplying blood collection tubes
8 and the fluid system and the like for preparing
9 and measuring samples as well as performing
10 other controls. The controller, control unit,
11 63 is a component of microcomputer 6 as shown in
12 Fig. 2. This is very clear.

13 BY MR. FEIGELSON:

14 Q. So I'm not asking you to read the
15 specification, Dr. Robinson. I'm asking for you
16 to tell the jury what is the controller that
17 you're identifying?

18 MR. SOBIERAJ: Objection. Asked and answered
19 many times.

20 THE WITNESS: I believe the specification is
21 the best place to point to the jury to what a
22 controller is.

23 BY MR. FEIGELSON:

24 Q. And what would you tell the jury a
25 controller is?

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1 MR. SOBIERAJ: Objection. Asked and
2 answered.

3 THE WITNESS: I would read 830 to 844. The
4 microcomputer 6 is provided with a controller 63
5 configured by a memory for the control processor
6 and the operation of the control processor and a
7 data analyzing unit 64 configured by a memory
8 for the analysis processor and the operation of
9 the analysis processor. The controller 63
10 controls the device 8 configured by a sampler
11 not shown in the drawing for automatically
12 supplying blood collection tubes and a fluid
13 system and the like for preparing and measuring
14 samples as well as performing other controls.

15 BY MR. FEIGELSON:

16 Q. And you believe that's clear to a jury
17 as to what a POSA would understand the
18 controller to be?

19 A. I think the best explanation to the
20 jury is perhaps what is in the specification.

21 Q. So are you identifying controller 63 as
22 the controller that a POSA would understand is
23 operating the multi-mode detector to sense
24 cells?

25 MR. SOBIERAJ: Objection to the form of the

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1 question.

2 THE WITNESS: I stand by my statement on Page
3 60, and I'm happy to read it again if you would
4 like.

5 BY MR. FEIGELSON:

6 Q. I've read it, and I've heard you read
7 it multiple times. I'm trying to understand
8 what you're saying and make sure the jury can
9 understand it, too. So I'm giving you an
10 opportunity to do that again if you choose,
11 Dr. Robinson. Would you like to explain to the
12 jury and the Court what exactly is the
13 controller that you believe a POSA would
14 understand is disclosed to operate a multi-mode
15 detector to sense cells?

16 MR. SOBIERAJ: Objection. Asked and
17 answered.

18 THE WITNESS: Yes. I'm happy to do that. I
19 would say to the jury the specification in 834
20 discloses that the controller 63 controls the
21 device 8 configured by a sampler which is not
22 shown in the drawing for automatically supplying
23 blood collection tubes and a fluid system and
24 the like for preparing and measuring samples as
25 well as performing other controls.

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1 BY MR. FEIGELSON:

2 Q. Anything else?

3 A. The controller, control unit, 63 is a
4 component of microcomputer 6 as shown in
5 Figure 2.

6 Q. And that's your identification of what
7 a controller is that would be understood by a
8 POSA to operate the multi-mode detector to sense
9 cells?

10 MR. SOBIERAJ: Objection to the form of the
11 question.

12 THE WITNESS: I stand by the statements that
13 I've made in my report.

14 BY MR. FEIGELSON:

15 Q. If your children came to you and asked
16 you what a controller was, what would you tell
17 them?

18 MR. SOBIERAJ: Objection. Outside the scope
19 of his report.

20 THE WITNESS: It's a hypothetical question,
21 and I try to avoid hypothetical questions.

22 BY MR. FEIGELSON:

23 Q. So you wouldn't be able to tell them
24 what a controller was?

25 MR. SOBIERAJ: Objection.

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1 THE WITNESS: It probably wouldn't matter
2 what I told them. They probably would ignore it
3 anyway.

4 BY MR. FEIGELSON:

5 Q. I'm asking what you would tell them.
6 It matters to me what you would tell them.

7 A. I don't think any of my children would
8 ask that sort of question, to be honest, because
9 none of them are engineers or technology people.

10 Q. And neither -- the jury might not
11 include engineers or technology people either.
12 So what would you tell them a controller is?

13 MR. SOBIERAJ: Objection. Objection to the
14 form of the question.

15 THE WITNESS: But the jury are not children,
16 so I don't know how to answer that.

17 BY MR. FEIGELSON:

18 Q. You don't know what you would tell the
19 jury what a controller is?

20 MR. SOBIERAJ: Objection to the form of the
21 question.

22 THE WITNESS: It's a hypothetical question.

23 BY MR. FEIGELSON:

24 Q. If the judge were to ask you:
25 Dr. Robinson, what do you understand a

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1 controller to be? What would you tell the
2 judge?

3 A. I would tell the judge: Judge, open
4 the patent. Look at Column 8 in Line 30. And
5 it would -- and I would read to the judge the
6 microcomputer 6 is provided with a controller 63
7 configured by a memory for the control processor
8 and the operation of the control processor and a
9 data analyzing unit 64 configured by a memory
10 for the analysis processor and the operation of
11 the analysis processor. The controller 63
12 controls the device 8 configured by a sampler --
13 not shown in the drawing -- I may not say that.
14 I may drop that little piece out for the judge
15 because he'd know that -- for automatically
16 supplying blood collection tubes and a fluid
17 system and the like for preparing and measuring
18 samples as well as performing other controls.
19 So that's what I would tell the judge.

20 Q. Okay.

21 MR. FEIGELSON: Rob, can we move over a new
22 exhibit? This will be 322, and it's the file --
23 it's called lasers.PDF.

24 (DDX Deposition Exhibit

25 No. 322 was remotely

July 28, 2021

1 that --

2 A. I'm sorry. I can't hear you.

3 Q. Who wrote the report that we are
4 talking about now?

5 A. Who wrote the report? I directed the
6 report, I spoke with attorneys, I researched,
7 evaluated documents, edited documents, and
8 worked with several attorneys over a significant
9 period of time.

10 Q. Did you write Paragraph 235 yourself?

11 A. I don't recall which paragraphs I
12 wrote. I wrote so many paragraphs that I would
13 not be able to identify specifically which
14 paragraphs that I wrote.

15 Q. But just to be clear, Dr. Robinson, as
16 you sit here, you cannot identify any places
17 other than Dr. Madisetti's report where you're
18 understanding that the XE-5000 is covered by
19 claims of the asserted patents; is that correct?

20 MR. SOBIERAJ: Objection. Mischaracterizes
21 his past testimony.

22 THE WITNESS: I believe I've stated that any
23 additional opinions or opinions that I may have
24 are in my report, and I stand by them.

25 BY MR. FEIGELSON:

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1 Q. How can you stand by them if you don't
2 know what they are?

3 A. I repeat: I don't recall if I have an
4 opinion on this. If I do have an opinion on it,
5 it will be in my report. And if it is in my
6 report, then I stand by it.

7 Q. How can you stand by something that you
8 don't even know if it exists?

9 A. This is a hypothetical question, and I
10 try to avoid hypothetical questions.

11 Q. This is not a hypothetical question.
12 This is a real question. How can you stand by
13 an opinion that you may or may not have?

14 MR. SOBIERAJ: Objection to the form of the
15 question.

16 THE WITNESS: I've made it clear that this is
17 a very long report. It's very detailed, and
18 there are a lot of opinions in it. And any
19 opinion that I have on this topic, if it is in
20 the report, I stand by it.

21 BY MR. FEIGELSON:

22 Q. So you're just speculating that there
23 may be other opinions as a basis for your
24 understanding that the XE-5000 is covered,
25 correct?

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1 MR. SOBIERAJ: Objection. Form of the
2 question.

3 THE WITNESS: I try to avoid speculation.

4 BY MR. FEIGELSON:

5 Q. But you can't point me to any paragraph
6 in your report that provides any basis other
7 than Dr. Madisetti's report for your
8 understanding that the XE-5000 is covered,
9 correct?

10 A. I've already stated that there may be
11 other opinions I have made on this topic. I do
12 not recall. And if I have made those opinions,
13 then I stand by them.

14 Q. And you blindly stand by them, right?

15 MR. SOBIERAJ: Objection. Form of the
16 question.

17 THE WITNESS: I provided a report that has a
18 considerable number of opinions in it. If I
19 have made an opinion on this topic, I stand by
20 it.

21 BY MR. FEIGELSON:

22 Q. Whether I can ask a question about it
23 or not, correct?

24 MR. SOBIERAJ: Objection. Form of the
25 question.